

REPLY

Serial No. 09/523,237
Atty. Docket No. GP068-03.CN1

Remarks

Claims 492 and 494-555 are presently pending in the subject application.

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

Claim 493 is cancelled herein without prejudice to the prosecution of the subject matter of this claim in this or a future continuing application.

Claim 492 is amended herein to incorporate the limitation of former claim 493, specifying that the nucleic acid polymerase of the claimed kit is an RNA polymerase.

Claims 547-555 are newly added herein.

New claim 547 is an independent claim that incorporates the limitation of claim 495 into previously unamended claim 492.

New claim 548 is an independent claim that incorporates the limitations of claim 496 into previously unamended claim 492. New claims 549 and 550 depend from claim 548 and track the language of claims 497 and 498, respectively.

New claim 551 is an independent claim that incorporates the limitations of claim 499 into previously unamended claim 492. New claims 552-554 depend from claim 551 and track the language of claims 500-502, respectively.

New claim 555 is an independent claim that tracks the language of previously unamended claim 492, but specifies that the amplification oligonucleotide is capable of directing the synthesis of a nucleic acid transcription product under amplification conditions. The language of claim 555 indicates that the recited amplification oligonucleotide contains a promoter sequence recognized by an RNA polymerase, a limitation that is not taught in the reference of record.

Interview Summary

Applicants wish to thank the Examiner for the courtesies extended during an in-person interview with Applicants' representative and one of the inventors of the subject application on August 5, 2003. Applicants note that the Examiner's Interview Summary accurately reflects the

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matters discussed during the interview and that the above amendments are consistent with the amendments proposed to the Examiner during the Interview.

Rejection Under 35 U.S.C. § 102

Claims 492, 493, 503 and 504 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Palfi *et al.* (PNAS USA, 88:9097-9101 (1991)). Applicants respectfully traverse this rejection for the reasons that follow.

Palfi is cited by the Examiner for disclosing the use of biotinylated 2'-O-methylated oligonucleotides to affinity purify snRNPs, where the purification products are identified using a primer extension assay requiring the presence of a polymerase. In response, Applicants first observe that the Examiner has failed to demonstrate that the biotinylated 2'-O-methylated oligonucleotides disclosed by Palfi are in fact capable of being extended or that such would be inherent from Palfi's disclosure. Second, because Palfi discloses a primer extension assay rather than a transcription-based amplification reaction, Applicants submit that Palfi fails to anticipate a kit, as claimed, which includes an amplification oligonucleotide containing a cluster of at least four ribonucleotides modified to include a 2'-O-methyl substitution to the ribofuranosyl moiety in combination with an RNA polymerase. Accordingly, withdrawal of this rejection is respectfully requested.

Claim Objections

Claims 494-502 stand objected to as being dependent upon a rejected base claim. Applicants submit that this objection is rendered moot by the amendments to the claims herein. Accordingly, withdrawal of this objection is respectfully requested.

Applicants submit that the subject application is in condition for allowance and early Notice to that effect is respectfully requested.

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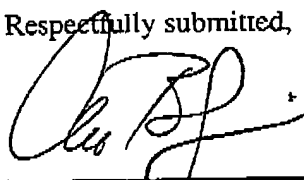
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Please charge any fees due in connection with this Substitute Reply, including the excess claims fee, to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 703-746-5206 on the date indicated below to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Respectfully submitted,



Date: August 26, 2003

By:

Charles B. Cappellari
Registration No. 40,937
Attorney for Applicants

GEN-PROBE INCORPORATED
Patent Department
10210 Genetic Center Drive
San Diego, California 92121
PH: 858-410-8927
FAX: 858-410-8928